

ESTTA Tracking number: **ESTTA165825**

Filing date: **10/01/2007**

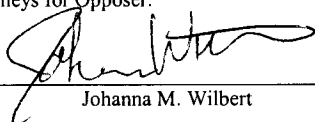
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92047262
Party	Plaintiff Roast of the Town, Inc.
Correspondence Address	HEATHER L. BUCHTA QUARLES & BRADY LLP 2 NORTH CENTRAL AVE, ONE RENAISSANCE SQUARE PHOENIX, AZ 85004 UNITED STATES tm-dept@quarles.com
Submission	Reply in Support of Motion
Filer's Name	Johanna M. Wilbert
Filer's e-mail	jwilbert@quarles.com
Signature	/Johanna M. Wilbert/
Date	10/01/2007
Attachments	Roast Reply.pdf (9 pages)(502646 bytes)

I hereby certify that this Reply Brief in Support of Summary Judgment is being electronically filed with the United States Patent and Trademark Office, Trademark Trial and Appeal Board, on the date set forth below.

I hereby further certify that a copy of the below Reply Brief in Support of Summary Judgment is being deposited with the United States Postal Service on the date set forth below as first class mail in an envelope addressed to: Harold L. Marquis at Thomas Kayden Horstemyer & Risly, LLP, 100 Galleria Parkway, NW Ste 1750 Atlanta, GA 30339, Attorneys for Opposer.

Date of Signature and Deposit: October 1, 2007


Johanna M. Wilbert

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Registration No. 2,760,766: ESPRESSIONE
Issued on September 9, 2003

Roast of the Town, Inc.,
Petitioner,

v.

Cancellation No. 92047262

Espressione International, Ltd.,
Respondent.

REPLY BRIEF IN SUPPORT OF SUMMARY JUDGMENT

INTRODUCTION

This is a simple matter. Petitioner has been using ESPRESSIONS in connection with custom blended coffees and teas continuously for the past eighteen years, significantly longer than Respondent's use of the ESPRESSIONE. Respondent has failed to identify any factual dispute that is relevant to the legal issues at hand or present evidence to refute priority. Therefore, Petitioner is entitled to summary judgment.

ARGUMENT

There are no genuine issues of material fact, therefore summary judgment is proper. Fed. R. Civ. P. 56. A factual dispute is genuine only if a reasonably jury could resolve a factual matter in favor of the non-moving party. Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248,

106 S. Ct. 2505, 91 L. Ed. 2d 265 (1986). A fact is material if that fact is “relevant and necessary to the proceedings.” Opryland USA Inc. v. The Great American Music Show Inc., 970 F.2d 847, 849-50 (Fed. Cir. 1992). Disputes regarding facts that would not alter the Board’s decision on the legal issue should not prevent the entry of summary judgment. Kellogg Co. v. Pack’em Enterprises, Inc., 951 F.2d 330, 333 (Fed. Cir. 1991).

Here, in an effort to confuse and complicate the issue, Respondent has focused on factual issues that are neither disputed nor relevant. Specifically, there is no genuine dispute regarding distinctiveness, abandonment of the previous registration, or whether there are any instances of actual confusion. Because these issues are neither relevant nor disputed, such issues do not preclude summary judgment from being entered in favor of Roast of the Town.

A. ESPRESSIONS is distinctive.

The following undisputed facts support the conclusion that ESPRESSIONS is a distinctive mark.

- The word “espressions” is not found in the dictionary or understood to have a common meaning. See Merriam-Webster’s Collegiate Dictionary attached as Exhibit A.
- ESPRESSIONS was sufficiently distinctive to obtain registration on the Principle Register as Registration No. 1,601,195. (Wilbert Decl. ¶ 3, Ex. 1.)
- The pending trademark application for ESPRESSIONS, Serial No. 78/851,222, was examined and was not rejected for lack of distinctiveness. (Wilbert Decl. ¶ 5, Ex. 3.)

Given these facts, Respondent’s assertion that there is a genuine dispute as to the mark’s distinctiveness is not credible. A mark consisting of a fanciful word that was previously found distinctive enough to be registered on the Principal Register does not lose its distinctiveness merely because Respondent has identified a handful of infringers. Respondent has put forth no

evidence showing that the mark has become generic or that it has ever been used as a descriptive term. Lacking such evidence, the undisputed fact is that the mark is distinctive.

B. Lack of registration does not equal abandonment.

It is undisputed that for a period of approximately three years and ten months there was no registration or application for the mark ESPRESSIONS; however, lack of a registered trademark does not equate to the abandonment of the mark. Rather, “[i]t is actual usage of a symbol as a ‘trademark’ in the sale of goods which creates and builds up rights in a mark” not whether a trademark registration was live. Mccarthy on Trademarks § 17:9. As a result, any dispute between Petitioner and her former counsel regarding the circumstances surrounding the abandonment of the previous registration and application is not relevant.

Rather, what is relevant is that the mark was used continuously from a period before Respondent’s use of the mark began to the present. Actual use has been established through declarations and exhibits, including business records, advertisements, and news articles. (Romberg Decl.; Paulsen Decl.; Wilbert Decl. Ex..) Respondent has submitted no factual evidence to challenge this fact of actual continuous use. There is no evidence that Petitioner’s coffee business ever ceased operations or that use of the mark was suspended for any period of time. As a result, there is no dispute over the material facts: the trademark registration lapsed, but the mark was in continuous use. As a result, there was no abandonment.

In an effort to create a dispute, Registrant has stated that “these exhibits raise many questions about material facts” but fails to identify any such questions. Registrant likewise alludes to the need for depositions, yet has failed to notice any such depositions despite the fact that discovery has been open since April. As such, Registrant’s unsupported claims that such discovery is needed appear disingenuous and should not be a reason to deny summary judgment.

C. Lack of actual confusion is not dispositive

“[T]he lack of any occurrences of actual confusion is not dispositive inasmuch as evidence thereof is notoriously difficult to come by.” Gillette Canada, Inc. v. Ranier Corp., 123 U.S.P.Q.2d 1768, 1992 TTAB LEXIS 24 (TTAB 1992). The test is whether confusion is likely to occur - not whether it actually did occur. On-line Careline, Inc. v. American Online, Inc., 229 F.3d 1080, 1084 (Fed. Cir. 2000).

The following undisputed facts support the conclusion that a likelihood of confusion exists:

- The Trademark Examining Attorney assigned to the ESPRESSIONS application applied the DuPont factors and determined that “contemporaneous use of the marks ESPRESSIONINE (used on coffee) and ESPRESSIONS (used on coffees and teas) would be likely to cause confusion.” (Wilbert Decl. ¶ 5, Ex. 3.)
- Both marks consist of eleven letters, the first ten letters of which are identical.
- Both marks are used on coffee.

Respondent has not offered any evidence to refute the fact that there is a likelihood of confusion.

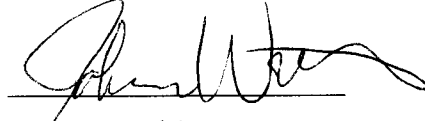
CONCLUSION

Petitioner has established prior use of a distinctive mark that is confusingly similar to Registrant’s. As a result, Petitioner respectfully requests that the Board grant Petitioner’s motion for summary judgment and cancel Registrant’s registration of ESPRESSIONE.

Dated: October 1, 2007.

Respectfully submitted,

ROAST OF THE TOWN, INC.

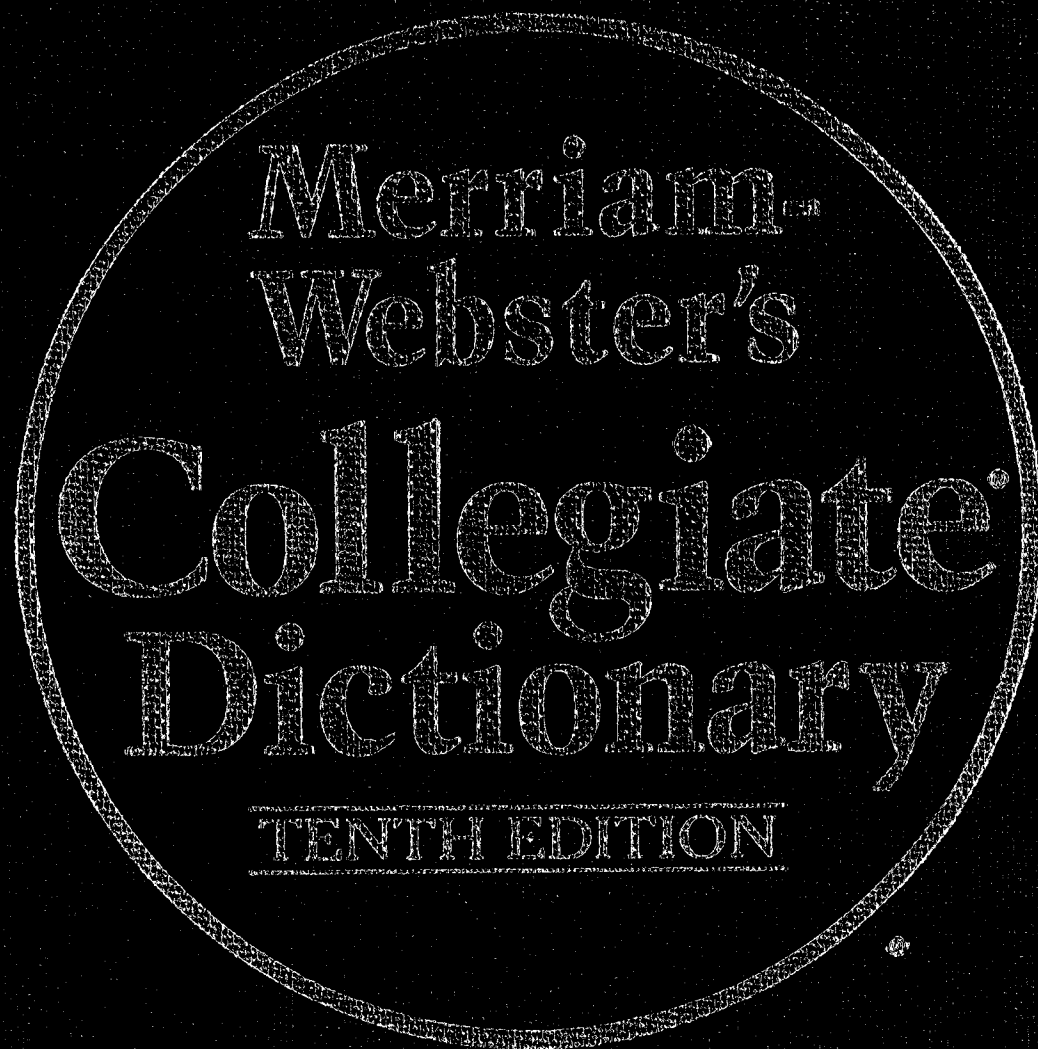
A handwritten signature in black ink, appearing to read "Robert L. Titley", written over a horizontal line.

Robert L. Titley
Johanna M. Wilbert
Quarles & Brady LLP
411 East Wisconsin Avenue
Milwaukee, WI 53202
Tel: (414) 277-5669

Heather L. Buchta
Quarles & Brady LLP
One Renaissance Square
Two North Central Avenue
Phoenix, AZ 85004-2391
Tel: 602-229-5200

Attorneys for Petitioner

Exhibit A



Merriam-
Webster's

Collegiate
Dictionary

TENTH EDITION



A GENUINE MERRIAM-WEBSTER

The name *Webster* alone is no guarantee of excellence. It is used by a number of publishers and may serve mainly to mislead an unwary buyer.

Merriam-Webster™ is the name you should look for when you consider the purchase of dictionaries or other fine reference books. It carries the reputation of a company that has been publishing since 1831 and is your assurance of quality and authority.

Copyright © 1999 by Merriam-Webster, Incorporated

Philippines Copyright 1999 by Merriam-Webster, Incorporated

Library of Congress Cataloging in Publication Data
Main entry under title:

Merriam-Webster's collegiate dictionary. — 10th ed.

p. cm.

Includes index.

ISBN 0-87779-708-0 (unindexed : alk. paper). — ISBN 0-87779-709-9 (indexed : alk. paper). — ISBN 0-87779-710-2 (deluxe indexed : alk. paper). — ISBN 0-87779-707-2 (laminated cover, unindexed).

1. English language—Dictionaries. I. Merriam-Webster, Inc.

PE1628.M36 1998

423—dc21

97-41846

CIP

Merriam-Webster's Collegiate® Dictionary, Tenth Edition principal copyright 1993

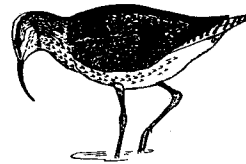
COLLEGIATE is a registered trademark of Merriam-Webster, Incorporated

All rights reserved. No part of this book covered by the copyrights hereon may be reproduced or copied in any form or by any means—graphic, electronic, or mechanical, including photocopying, taping, or information storage and retrieval systems—without written permission of the publisher.

Made in the United States of America

2526WC99

es-crow \es-'krō, 'es-\ vt (1949): to place in escrow
es-cu-do \is-'kü-(j)dō\ n, pl -dos [Sp & Pg. lit., shield, fr. L *scutum*] (ca. 1821) 1: any of various former gold or silver coins of Hispanic countries 2 — see MONEY table 3: the basic monetary unit of Chile between 1960 and 1975 4: the peso of Guinea-Bissau
es-cu-lent \es-'kyə-lant\ adj [L *esulentus*, fr. *esca* food, fr. *edere* to eat — more at EAT] (1626): EDIBLE — **esulent** n
es-cutch-eon \is-'kə-čən\ n [ME *escuchon*, fr. MF *escuchon*, fr. (assumed) VL *scution*, *scutio*, fr. L *scutum* shield — more at ESQUIRE] (15c) 1: a defined area on which armorial bearings are displayed and which usu. consists of a shield 2: a protective or ornamental plate or flange (as around a keyhole) 3: the part of a ship's stern on which the name is displayed
Es-dras \ez-'drās\ n [LL, fr. Gk. fr. Heb. 'Ezra] 1: either of two books of the Roman Catholic canon of the Old Testament: a: EZRA 2 b: NEHEMIAH 2 2: either of two uncanonical books of Scripture included in the Protestant Apocrypha — see BIBLE table
ese \ēz, 'ēs\ adj suffix [Pg -ēs & It -ese, fr. L -ensis] of, relating to, or originating in (a certain place or country) (Japanese)
ese n suffix, pl -ese 1: native or resident of (a specified place or country) (Chinese) 2 a: language of (a particular place, country, or nationality) (Siamese) b: speech, literary style, or diction peculiar to (a specified place, person, or group) — usu. in words applied in depreciation (journalism)
es-em-plas-tic \e-'sem-'plas-tik, -səm-\ adj [Gk *es hen* into one + E *plastic*] (1817): shaping or having the power to shape disparate things into a unified whole (the ~ power of the poetic imagination — W. H. Gardner)
es-er-ine \e-'sə-'rēn\ n [F *ésérine*] (1879): PHYSOSTIGMINE
es-ker \es-'kər\ n [Ir *eisicir* ridge] (1848): a long narrow ridge or mound of sand, gravel, and boulders deposited by a stream flowing on, within, or beneath a stagnant glacier
Es-ki-mo \es-'kə-'mō\ n [obs. *Esquimaue*, prob. fr. Sp *esquima*, fr. Montagnais (Algonquian language of eastern Canada) *aiachkime8* Micmac, Eskimo; prob. akin to modern Montagnais *assimew* she laces a snowshoe, Ojibwa *askime*] (1584) 1 pl **Eskimo** or **Eskimos**: a member of a group of peoples of northern Canada, Greenland, Alaska, and eastern Siberia 2: any of the languages of the Eskimo peoples — **Es-ki-mo-an** \es-'kə-'mō-'ən\ adj
Eskimo curlew n (1813): an extremely rare New World curlew (*Numenius borealis*) that breeds in northern No. America and winters in So. America
Eskimo dog n (1774): a sled dog of American origin
ESOP \e-'es-(j)ō-'pē, 'ē-'sāp\ n [employee stock ownership plan] (1975): a program by which a corporation's employees acquire its capital stock
esoph-a-gus \i-'sā-'fə-'gəs\ n, pl -gi \-gi, -ji\ [ME *esophagus*, fr. Gk *oisophagos*, fr. *oiosein* to be going to carry + *phagein* to eat — more at BAKSHEESH] (14c): a muscular tube that in humans is about nine inches long and passes from the pharynx down the neck between the trachea and the spinal column and behind the left bronchus where it pierces the diaphragm slightly to the left of the middle line and joins the cardiac end of the stomach — **esoph-a-ge-al** \i-'sā-'fə-'jē-'əl\ adj
es-o-ter-ic \e-'sə-'ter-ik\ adj [LL *esotericus*, fr. Gk *esōterikos*, fr. *esōterō*, compar. of *eisō*, *esō* within; fr. *eis* into; akin to Gk *en* in — more at IN] (ca. 1660) 1 a: designed for or understood by the specially initiated alone (a body of ~ legal doctrine — B. N. Cardozo) b: of or relating to knowledge that is restricted to a small group 2 a: limited to a small circle (~ pursuits) b: PRIVATE, CONFIDENTIAL (an ~ purpose) — **es-o-ter-i-cal-ly** \i-'kə-(ə-)lē\ adv
es-o-ter-i-ca \i-'kə-\ n pl [NL, fr. Gk *esōterika*, neut. pl. of *esōterikos*] (ca. 1929): esoteric items
es-o-ter-i-cism \-ter-'ə-'si-'zəm\ n (1846) 1: esoteric doctrines or practices 2: the quality or state of being esoteric
ESP \ē-'es-'pē\ n [extrasensory perception] (1934): EXTRASENSORY PERCEPTION
es-pa-drille \es-'pə-'dril\ n [F, alter. of *espadille*, ultim. fr. L *spartum*] (1892): a sandal usu. having a fabric upper and a flexible sole
es-pal-ier \is-'pal-'yər, -yā\ n [F, ultim. fr. It *spalla* shoulder, fr. LL *spatula* shoulder blade — more at EPAULET] (1662) 1: a plant (as a fruit tree) trained to grow flat against a support (as a wall) 2: a railing or trellis on which fruit trees or shrubs are trained to grow flat
espalier vt (1810) 1: to train as an espalier 2: to furnish with an espalier
es-par-to \is-'pär-(t)ō\ n, pl -tos [Sp, fr. L *spartum*, fr. Gk *sparton* — more at SPIRE] (1845) 1: either of two Spanish and Algerian grasses (*Stipa tenacissima* and *Lygeum spartum*) used esp. to make cordage, shoes, and paper — called also *esparto grass* 2: the fiber of esparto
es-pe-cial \is-'pē-'shəl\ adj [ME, fr. MF — more at SPECIAL] (14c): being distinctive: as a: directed toward a particular individual, group, or end (sent ~ greetings to his son) (took ~ care to speak clearly) b: of special note or importance: unusually great or significant (a decision of ~ relevance) c: highly distinctive or personal: PECULIAR (had an ~ dislike for music) d: CLOSE, INTIMATE (his ~ crony) e: SPECIFIC, PARTICULAR (had no ~ destination in mind) **syn** see SPECIAL — **in especial**: in particular
es-pe-cial-ly \is-'pē-'shē-'lē, -'pē-'shā-\ adv (15c) 1: SPECIALLY 1 2 a: in particular: PARTICULARLY (food seems cheaper, ~ meats) b: for a particular purpose (built ~ for research) 3 — used as an intensive (an ~ good essay) (nothing ~ radical in the remarks)
es-per-ance \es-'p(ə-)rən(t)s\ n [ME *esperaunce*, fr. MF *esperance*] (15c) obs: HOPE, EXPECTATION
Es-pe-ran-to \es-'pə-'rān-(t)ō, -'rān-(t)ō\ n [Dr. Esperanto, pseudonym of L. L. Zamenhof †1917 Pol. oculist, its inventor] (1892): an artificial international language based as far as possible on words common to the chief European languages — **Es-pe-ran-tist** \-rān-'tist, -'rān-\ n or adj



Eskimo curlew

es-pi-al \is-'pi-(ə)-əl\ n (14c) 1: OBSERVATION 2: DISCOVERY
es-pie-gle \es-'pyē-glē\ adj [F, after *Ulespiegle* (Till ant. prankster) (1816): FROLICHSOME, ROGUISH
es-pie-gle-rie \es-'pyē-glē-'rē\ n [F, fr. *espigle*] (18c): state of being roguish or frolicsome
es-pi-o-nage \es-'pē-'ə-'nāzh, -'nā-, -'ni-, Canad o 'nāzh; is-'pē-'ə-'ni-)\ n [F *espionnage*, fr. MF, fr. *espion* spy, fr. OIt *spione*, fr. *spia*, of Gmc origin; akin spy — more at SPY] (1793): the practice of spying to obtain information about the plans and activities of an enemy or a competing company (industrial ~)
es-pla-nade \es-'plā-'nād, -'es-'plā-' also -'nād or -'spianād, fr. *spianare* to level, fr. L *explanare* — (1591): a level open stretch of paved or grassy ground signed for walking or driving along a shore
es-pous-al \is-'pau-'zəl also -səl\ n (14c) 1 a: B DING c: MARRIAGE 2: a taking up or adopting of
es-pouse \is-'pauz also -'pauz\ vt **es-poused**; **es-po** **es-pouser**, fr. LL *sponsare* to betroth, fr. L *sponsus* b spouse] (15c) 1: MARRY 2: to take up and suppt come attached to **syn** see ADOPT — **es-pous-er** n
es-pres-so \e-'spre-'(j)sō\ n, pl -sos [It *caffè* *espresso* coffee] (1945) 1: coffee brewed by forcing steam ground darkly roasted coffee beans 2: a cup of **es**
es-prit \is-'pre\ n [F, fr. L *spiritus* spirit] (1591) 1: ness or wit 2: ESPRIT DE CORPS
es-prit de corps \is-'prē-'də-'kōr, -'kōr\ n [F] (17c) spirit existing in the members of a group and in devotion, and strong regard for the honor of the grc
es-py \is-'pi\ vt **es-pied**; **es-py-ing** [ME *espier*, fr. (C SPY) (14c): to catch sight of (among the several h the white mustang — Zane Grey)
-esque \esk\ adj suffix [F, fr. It -esco, of Gmc origin -ish — more at -ISH] in the manner or style of: lik
Es-qui-mau \es-'kə-'mō\ n, pl **Esquimaux** or **Es-q** [F, fr. Montagnais (Algonquian language)] (1744):
Es-quire \es-'kwir, is-\ n [ME, fr. MF *esquier* squi fr. L *scutum* shield; akin to OIt *sciath* shield] (15c) the English gentry ranking below a knight 2: a ci hood serving as shield bearer and attendant to a kni title of courtesy usu. placed in its abbreviated form (John R. Smith, *Esq.*) 4 *archaic*: a landed propriet
ess \es\ n (1540) 1: the letter s 2: something re S in shape; *esp*: an S-shaped curve in a road
-ess \əs, is also, 'es\ n suffix [ME -esse, fr. OF, fr. L] male (giantess)
es-say \e-'sā, ə-'sā, 'e-'sā\ vt (14c) 1: to put to a t often tentative or experimental effort to perform: TEMPT — **es-say-er** n
es-say \e-'sā; senses 1, 2 & 4 also e-'sā\ n [ME, fr. LL *exagium* act of weighing, fr. *ex-* + *agere* to drive (14c) 1: TRIAL TEST 2 a: EFFORT, ATTEMPT; *esp*: effort b: the result or product of an attempt 3 interpretative literary composition usu. dealing with limited or personal point of view b: something composition (a photographic ~) 4: a proof of an for a stamp or piece of paper money
es-say-ist \e-'sā-'ist\ n (1601): a writer of essays
es-say-is-tic \e-'(j)sā-'is-tik\ adj (1862) 1: of or rel. an essayist 2: resembling an essay in quality or ch
essay question n (1947): an examination questio answer in a sentence, paragraph, or short composit
es-sence \e-'sē-'n(t)s\ n [ME, fr. MF & L; MF, fr. L *es* — more at IS] (14c) 1 a: the permanent as contri dental element of being b: the individual, real, or t thing esp. as opposed to its existence c: the prop by means of which something can be placed in its p tified as being what it is 2: something that exists: a volatile substance or constituent (as of perfume, ent or derivative possessing the special qualities (as in concentrated form; also: a preparation of such a thetic substitute b: ODOR, PERFUME 4: one that pe a quality in abundance as if in concentrated form: punctuality) — **in essence**: in or by its very nat BASICALLY (was in essence an honest person) — **of** the utmost importance (time is of the essence)
Es-sene \i-'sen, 'e-'sēn\ n [Gk *Essēnos*] (1553): a m tic brotherhood of Jews in Palestine from the 2d cer century A.D. — **Es-se-ni-an** \i-'sē-'nē-'ən, e-'sē-\ or E -'sē-'nik\ adj — **Es-se-nism** \i-'sē-'ni-'zəm\ n
es-sen-tial \i-'sen(t)-shəl\ adj (14c) 1: of, relating essence: INHERENT 2: of the utmost importance ABLE, NECESSARY (~ foods) (an ~ requirement for lege) 3: IDIOPATHIC (~ disease) — **es-sen-tial-ly** \i-'sen-'chəl-'nəs\ n
syn ESSENTIAL, FUNDAMENTAL, VITAL, CARDINAL mea to be indispensable. ESSENTIAL implies belonging to a thing and therefore being incapable of removal v the thing itself or its character (conflict is essential MENTAL applies to something that is a foundation entire system or complex whole would collapse (u ples of algebra). VITAL suggests something that thing's continued existence or operation (cut off fr CARDINAL suggests something on which an outcome a cardinal rule in buying a home).
essential n (15c) 1: something basic (the ~s t: something necessary, indispensable, or unavoidable
essential amino acid n (1935): an amino acid (as l normal health and growth, manufactured in the b quantities or not at all, and usu. supplied by dietary p
es-sen-tial-ism \i-'li-'zəm\ n (1927) 1: an educat ideas and skills basic to a culture should be taught tc tested methods — compare PROGRESSIVISM 2: a ph